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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/308,451	05/19/1999	ROBERT G. SCHWARTZ	8001.104/00	6174

7590 12/18/2003

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

26

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No. 09/308,451	Applicant(s) SCHWARTZ ET AL.	
	Examiner Sam Rimell	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 89-106 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 and 89-106 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

SAM RIMELL
PRIMARY EXAMINER

Preliminary Note: In view of applicant's arguments submitted with the appeal brief of September 25, 2003, the previous grounds of rejection are hereby withdrawn. However, new grounds of rejection are applied in light of newly cited prior art which accompanies this office action. Accordingly, the finality of the previous action is vacated and this office action is made non-final.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 and 89-105 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. (US Patent Application Publication 2002/0073040).

Applicability of Schwartz et al. as prior art: The reference to Schwartz et al. meets the requirements for prior art under 35 USC 102(e)(1). The reference is a patent application publication; it is filed by another (it includes inventors not in common with the present application--- see MPEP 2136.04); and the critical reference date is a provisional application in the priority claim of the publication (See MPEP 2136.03, Section III). This provisional application cited in Schwartz et al. has a filing date of April 23, 1996, which precedes applicant's priority claim of September 22, 1997. The reference is therefore applicable as prior art under 35 USC 102(e).

Claim 1: FIG. 8 illustrates a data structure in the form of a plurality of postal data elements. These data elements are processed by the mail processing apparatus (150). A first data

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element is the digital signature (801i). A second data element is the postal data block (801h). The first data element (digital signature) is a function of the second data element (postal data) in the sense that the first data element (digital signature) is not created and cannot be created until all of the other data elements are created. The digital signature is based on all the previous data elements (page 6, paragraph 0069). As seen in FIG. 8, the second data element (postal data) precedes the first data element (digital signature). The printer (190) is the output for providing a representation (FIG. 7) representing the data elements.

Claim 2: The representation of FIG. 7 includes a barcode (710).

Claim 3: The barcode (710) is two-dimensional.

Claim 4: The barcode (710) is a data matrix symbol.

Claim 5: The second data element (postal data) pertains to a postage value while the first data element is related to a descending register (see page 3, first paragraph on page).

Claim 6: The barcode (710) is also a bitmap of encoded symbols.

Claim 7: FIG. 8 illustrates a plurality of postal elements. The block 801(h) (postal data) can be designated as the "second data element". Each block preceding the second data element is independent of that data element. The printer (190) is the output which prints out a representation (FIG. 7) of the postal data element.

Claim 8: See remarks for claim 2.

Claim 9: See remarks for claim 3.

Claim 10: See remarks for claim 4.

Claim 11: See remarks for claim 5.

Claim 12: See remarks for claim 6.

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Claim 13: Fig. 1 illustrates a mail processor. FIG. 7 illustrates a representation. The representation includes a first subset of data (705) that is not subject to change with each franking transaction. Namely, this is the identification of the postal meter, its location and registration number. A second subset of data (710) is subject to change with each franking transaction. The second subset of data is further illustrated in FIG. 8 and includes various blocks of data, all of which are subject to change with each different franking transaction. As seen in FIG. 7, the first subset and second subsets are partitioned from each other.

Claim 14: Portion (710) of FIG. 7 is a coded symbol.

Claim 15: See remarks for claim 2.

Claim 16: See remarks for claim 3.

Claim 17: See remarks for claim 4.

Claim 18-19: Both the portions (705) and (710) are readable as coded symbols (even printing in plain English is considered a “coding” when the claims do not recite what kind of coding is performed). Thus, it follows that both the first and second subsets of data (705, 710), as partitioned into first and second parts, have coded symbols.

Claim 20: See remarks for claim 13.

Claim 21: In Schwartz et al., the first symbol is the portion (705) in FIG. 10. Since this portion does not change with multiple transaction, it can be considered as generated prior to the transaction unique portions (710).

Claim 22: See remarks for claim 2.

Claim 23: See remarks for claim 3.

Claim 24: See remarks for claim 4.

Claim 25: The output includes a printer (190).

Claim 26: The first data is a digital signature, such shown in FIG. 8. The “predicted second data” is the table of rates and mail classes (paragraph 0025) stored in storage device (156). The “actual second data” is data input by the user regarding the characteristics of the package, such as the weight and delivery zip code (steps 430-450 in FIG. 4). The processor compares the predicted second data with the actual second data and then generates the digital signature (first data) and postal indicium carrying that signature.

Claims 27-28: The predicted second data concerns postage values and mail classes.

Claim 29: The predicted second data are statistics in a memory table.

Claim 30: The predicted version of the second data is a set of postage values and can be any value.

Claims 31-32: The first value is an authenticating code or digital signature.

Claim 33: The processor includes software for making the comparison between the predicted second data and actual second data.

Claim 34: In Schwartz et al., the interface (150) receives a request to create a postal indicium. The processor (155) performs computations. Any data which is saved and used repeatedly, such as the field (705) showing the location and registration number of the meter are considered computations performed before the request is received. FIG. 8 includes data fields that are created after the request is received.

Claim 35: Block 801i in FIG. 8 is a digital signature which is code that is created after the request to create the indicium is received.

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Claims 36-39: As described in paragraph 32 on page 3, the digital signature is based on a digital signature algorithm that uses public and private keys. Public and private keys are generated based on random numbers.

Claim 89: Schwartz et al. includes a printer (190).

Claim 90: FIGS. 3A and 3B of Schwartz et al. illustrate a mail piece having the indicia.

Claim 91: In FIGS. 3A and 3B, the indicia is on the mail piece.

Claim 92: See remarks for claim 89.

Claim 93: See remarks for claim 90.

Claim 94: See remarks for claim 91.

Claim 95: See remarks for claim 89.

Claim 96: See remarks for claim 90.

Claims 97-100: See remarks for claim 91.

Claim 101: See remarks for claim 89.

Claim 102: See remarks for claim 90.

Claim 103: See remarks for claim 91.

Claim 104: See remarks for claim 89.

Claim 105: See remarks for claim 90.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40-43, 45 and 106 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilham (U.S. Patent 5,200,903, previously cited of record).

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Claim 40: Gilham discloses a printer (22) having two separate print heads (28) and (31). The print head (28) is used to print the postage mark while the print head (31) is used to print the address. The gap space between the two print heads is readable as a delimiter.

Claim 41: The symbol (29) is a data matrix symbol.

Claims 42-43: The symbol (29) may be considered either “dark on light” or “light on dark” since the claims do not specify which item is light and which item is dark. Thus, these two terms only suggest that some contrast exists.

Claim 45: The symbol (29) includes a barcode at its outer edge.

Claim 106: The envelope is a medium having a postal indicia thereon.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 40 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Emmett et al. (U.S. Patent 5,699,257).

Claim 40: FIG. 3 illustrates a roller having two print head sections. The two print head sections print first and second segments. The first segment includes a date stamp and eagle, the second segment includes a numerical postage indication. The two sections are separated by a line, which as the delimiter, since it separates the sections.

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Claim 44: Any of the printed indicia in FIG. 3 is readable as a finder pattern. The delimiter (line) is part of the finders pattern (printed indicia).

This office action is non-final .

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', with a stylized flourish at the end.

Sam Rimell
Primary Examiner
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